

REMARKS

Applicants acknowledge receipt of an Office Action dated November 25, 2003. In this response, Applicants have amended claims 1, 15 and 21 to incorporate subject matter from claim 2. Accordingly, Applicants have cancelled claim 2 without prejudice or disclaimer. Following entry of these amendments, claims 1 and 3-27 are pending in the application.

Reconsideration of the present application is respectfully requested in view of the foregoing amendments and the remarks which follow.

Rejections Under 35 U.S.C. §102

On page 2 of the Office Action, the PTO has rejected claims 1-7, 9-12, 15-21 and 24 under 35 U.S.C. §102(b) as being anticipated by U.S. Patent 5,841,360 to Binder (hereafter "Binder"). In this response, Applicants have amended claims 1, 15 and 21 to incorporate subject matter from claim 2 and have cancelled claim 2 without prejudice or disclaimer. Applicants respectfully traverse the PTO's §102 rejection for the following reasons.

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. *Verdegaal Bros. v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). See generally MPEP §2131. Here, Binder fails to disclose an "apparatus for actuating a control element for a heating or air-conditioning system in a motor vehicle...wherein the circuit is integrated into cable" as recited in independent claims 1 and 21 or a "method for installing an apparatus for actuating a control element for a heating or air-conditioning system in a motor vehicle, comprising...installing an electrical circuit...wherein the circuit is integrated into the cable..." as recited in independent claim 15.

Applicants submit that claims 3-7, 9-12, 16-20 and 24 are each allowable for the same reasons as the independent claim from which each claim ultimately depends.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection under §102.

Rejections Under 35 U.S.C. §103

On page 3 of the Office Action, the PTO has rejected claim 8 under 35 U.S.C. §103 as being unpatentable over Binder in view of U.S. Patent 5,847,976 to Lescourret (hereafter “Lescourret”). In addition, on page 4 of the Office Action, the PTO has rejected claims 13 and 14 under 35 U.S.C. §103 as being unpatentable over Binder in view of U.S. Patent 5,698,992 to El Ayat *et al.* (hereafter “El Ayat”). Finally, the PTO, on page 4 of the Office Action, has rejected claims 22, 23, 25, 26 and 27 under 35 U.S.C. §103 as being unpatentable over Binder in view of U.S. Patent 6,225,769 to Brenner *et al.* (hereafter “Brenner”). In this response, Applicants have amended claims 1, 15 and 21 to incorporate subject matter from claim 2 and have cancelled claim 2 without prejudice or disclaimer. Applicants respectfully traverse the PTO’s §103 rejections for the following reasons.

To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 180 USPQ 580 (CCPA 1974). See MPEP §2143.03. Here, none of the cited references, namely Binder, Lescourret, El Ayat and Brenner, taken either individually or in fair combination, teaches or properly suggests either an “apparatus for actuating a control element for a heating or air-conditioning system in a motor vehicle...wherein the circuit is integrated into cable” as recited in independent claims 1 and 21 or a “method for installing an apparatus for actuating a control element for a heating or air-conditioning system in a motor vehicle, comprising...installing an electrical circuit...wherein the circuit is integrated into the cable...” as recited in independent claim 15.

If an independent claim is nonobvious under §103, then any claim depending therefrom is nonobvious. *In re Fine*, 5 USPQ2d 1596 (Fed. Cir. 1988). See MPEP §2143.03. Thus, Applicants submit that claims 8, 13, 14, 22, 23, 25, 26 and 27, which each ultimately depend from one of independent claims 1, 15 and 21, are also non-obvious.

In addition, with respect to dependent claims 8, 13, 14, 22, 23, 25, 26 and 27, Applicants note that each of these claims is directed to the motor vehicle context, a context quite different from that of Binder. To establish a *prima facie* case of obviousness, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to

combine reference teachings. The teaching or suggestion to make the claimed combination must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143. Here, Applicants submit that the PTO has failed to establish a proper motivation for modifying Binder for use in the motor vehicle context of the presently claimed invention. Accordingly, Applicants submit that the outstanding obviousness rejection is improper and should be withdrawn.

In view of the foregoing, Applicants respectfully request reconsideration and withdrawal of the outstanding rejections under §103.

CONCLUSION

Applicant believes that the present application is now in condition for allowance. Favorable reconsideration of the application as amended is respectfully requested.

The Examiner is invited to contact the undersigned by telephone if it is felt that a telephone interview would advance the prosecution of the present application.

Respectfully submitted,

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The Commissioner is hereby authorized to charge any additional fees which may be required regarding this application under 37 C.F.R. §§ 1.16-1.17, or credit any overpayment, to Deposit Account No. 19-0741. Should no proper payment be enclosed herewith, as by a check being in the wrong amount, unsigned, post-dated, otherwise improper or informal or even entirely missing, the Commissioner is authorized to charge the unpaid amount to Deposit Account No. 19-0741. If any extensions of time are needed for timely acceptance of papers submitted herewith, Applicant hereby petitions for such extension under 37 C.F.R. §1.136 and authorizes payment of any such extensions fees to Deposit Account No. 19-0741.